



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

KNOBLE, YOSHIDA & DUNLEAVY
EIGHT PENN CENTER
SUITE 1350, 1628 JOHN F KENNEDY BLVD
PHILADELPHIA PA 19103

COPY MAILED

NOV 23 2005

OFFICE OF PETITIONS

In re Application Of	:	DECISION ON REQUEST FOR
Fukashiro et al.	:	RECONSIDERATION OF
Application No. 09/966,052	:	DECISION ON APPLICATION
Filed: September 28, 2001	:	FOR
Atty Docket No. HITACHI-0025	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "REQUEST FOR RECONSIDERATION ON DECISION FOR APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)," filed April 8, 2005. Applicants requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from forty-eight (48) days to one hundred ninety-two (192) days.

The request for reconsideration of decision on application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one hundred ninety-two (192) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 4, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 48 days. The initial application for patent term adjustment was timely filed¹. Applicants submit that a reduction of 144 days, under 37 CFR § 1.704(c)(7), for failing to properly respond to a Notice of Non-Compliance is in error. Applicants submit that timely responses were made to the Notice

¹ PALM records show that the Issue Fee payment was also received July 14, 2004.

of Non-Compliance, however, the United States Patent and Trademark Office wrongly continued to issue Notices of Non-Compliance. Applicants contend that the Office erred in determining that their response after non-final received July 7, 2003 and their response to Notice of Non-compliant Amendment were Non-Compliant for failing to adhere to the new Amendment format. Applicants submit that the Amendment of July 7, 2003 was compliant as it was not required to be in the new Amendment format, and that the Notice of Non-Compliance was in error. Further, applicants state that as the July 28, 2003 amendment was filed before July 30, 2003, it was also not required to be in the new Amendment format.

37 C.F.R. § 1.704(c)(7) provides that:

Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

Petitioners' arguments were considered, and determined to be persuasive to an extent. A review of the record revealed that: By Notice mailed July 22, 2003, applicants were advised that the reply filed July 7, 2003 was an informal or non-responsive amendment. A review of the amendment finds the amendment was compliant with rule 1.121. Nonetheless, applicants responded with the filing of an amendment on July 28, 2003. A review of this amendment reveals that it was compliant with rule 1.121, then in effect. Thus, neither the amendment filed July 7, 2003 nor the amendment filed July 28, 2003 had any omissions, relative to satisfying rule 1.121.

However, the application for patent term adjustment filed July 14, 2004, was dismissed because it was concluded that the replies did have omissions. Specifically, by Office action mailed October 29, 2003, the examiner made clear that the replies filed on July 7, 2003; July 10, 2003; and July 28, 2003 were not fully response to the Office action mailed April 4, 2003, because the "claimed subject matter is completely different." Specifically, the examiner explained that both sets of claims 1-7 were numbered the same; however, the claimed subject matter was completely different. On November 28, 2003, applicants submitted a new response, correcting the omission.

On instant request for reconsideration, applicants continue to argue that the original notice of non-compliance was erroneously

issued. Applicants continue to maintain that the new Amendment format was not, in effect.

In response, it is preliminarily stated that the basis for dismissing the original application for patent term adjustment was not failure to comply with 1.121. As stated above, the omission relied on was the error in the claims cited by the examiner in the October 29, 2003 Office action. Based on the perceived correction of this error by filing of a response on November 28, 2003, the reduction of 144 days was sustained.

However, a further review of the record supports a conclusion that the error cited by the examiner was not correct. The record reveals that the examiner stated that the "claimed subject matter is completely different" because the amendment reviewed by the examiner was from a different application. Thus, the Notice of Non-compliance was mailed in error. Accordingly, it is concluded that the reductions totaling 144 days are unwarranted.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is one hundred ninety-two (192) days.

No fee is required on instant request for reconsideration and none has been charged.

The Office will forward the file to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent will include any patent term accrued for Office delay in issuing the patent after payment of the issue fee and meeting of all outstanding requirements.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.



Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Updated PAIR Screen